

applicant is submitting herewith the declaration of Mr. Pearce. The declaration provides comparative data which it is believed underscores the unobviousness of the invention over Jolley and the other cited prior art.

As required by the Examiner in Section 1, page 2 of the action, a new more descriptive title has been presented.

Additionally, various changes have been made in the claims to obviate the Examiner's Section 112, 2nd ¶ and Section 101 rejections as set out in Sections 2 and 3 of the action. In particular, claims 14-18, 22-24 and 28 have been cancelled and claims 5, 8, 20, 21 and 27 have been amended to depend from claim 29. With entry of the present amendments, the claims in the case are claims 5, 8, 20, 21, 27 and 29.

The indicated amendments to the claims are thought to remove the basis for the Examiner's Section 112 and Section 101 rejections. Accordingly, withdrawal thereof is requested.

The amendments to claim 29 require R^2 to be the hydrocarbon radical remaining after the removal of the hydroxyl groups from pentaerythritol or dipentaerythritol, i.e. the reference to trimethylol propane has been deleted from claim 29.

The carbon content for the R^3 alkyl, whether linear and/or branched, has also been added to claim 29. Additionally, the F definition of p has been narrowed and functional language has been added at the end of claim 29 to bring out the advantages of using the applicant's lubricant.

Basis for the matter added to claim 29 is found, for example, at page 15, lines 20-22 and lines 30-32; the ¶ bridging pages 17-18 and page 17, lines 14-19.

1

The applicant respectfully submits that the claims, as amended herein, define subject matter which is unobvious from and, therefore, patentable over Jolley WO 90/12849 even if this reference is considered with Yoshida or Shiflett. It is submitted that there is no motivation in any of the references to make the modifications or selections needed in, for example, Jolley to reach the applicant's invention. The Jolley disclosure provides very generalized teachings which could not lead one in the art to the applicant's specific invention and its advantages. The secondary references do not fill in the deficiencies of Jolley as far as the applicant's invention is concerned.

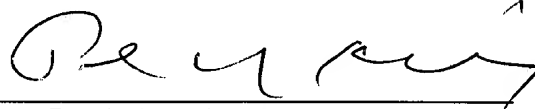
The unobviousness of the applicant's invention is underscored by the attached Pearce declaration. This declaration speaks for itself and its contents need not be repeated here. It is believed sufficient to note that compositions representative of the invention (using ISO 22 ester or ISO 32 ester) have been compared with compositions according to Examples 1, 2, 6 and 11 of Jolley. The results of these tests are shown in ¶s 14 and 15 of the declaration and discussed in ¶s 16-19. ¶ 19 summarizes the results and the unobviousness thereof. The Examiner is requested to consider the declaration, including the evidence presented therein, as this clearly shows that Jolley is not suggestive of the present invention.

In view the foregoing, and the attached declaration, reconsideration of the Section 103(a) rejection with withdrawal of the rejection and allowance of the application is respectfully requested.

Respectfully submitted,

CUSHMAN DARBY & CUSHMAN
Intellectual Property Group of
Pillsbury Madison & Sutro, LLP

By



Paul N. Kokulis
Reg. No. 16773

PNK:mh
1100 New York Avenue, N.W.
9th Floor - East Tower
Washington, D.C. 20005-3918
Phone: (202) 861-3503

1